



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/559,261	04/27/2000	Shuji Nakamura	122.1407	2241

21171 7590 05/28/2002

STAAS & HALSEY LLP
700 11TH STREET, NW
SUITE 500
WASHINGTON, DC 20001

EXAMINER

EISEN, ALEXANDER

ART UNIT PAPER NUMBER

2674

DATE MAILED: 05/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TR

Office Action Summary

Application No.

09/559,261

Applicant(s)

NAKAMURA ET AL.

Examiner

Alexander Eisen

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 recites the limitation "said connecting part" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim. Changing the limitation to —said connector part—would overcome this rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Oka, US 5,049,863.

Oka discloses a pointing device (16) comprising an operating part (key 17a-d), a detecting part (42-43 in FIG. 7) and a connector part (19) arranged adjacent to the operating part and being detachably attached to a data processor (see FIG. 5) and also serving to support said operating part and detecting part, when the connector is connected to the data processor.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Niino, US 5,714,980.

Niino discloses a pointing device (1) comprising a base part (substrate 8); an operating part (4) supported on said base part (8) in a rockable manner about a fulcrum (9a); a magnet (11-14) carried on operating part (4); and an elastic member (7) arranged between the base part (8) and the operating part (4) to elastically push said operating part toward an initial balanced position on said base part, said elastic member having a first section (the bottom of annular member 7) engageable with said base part and a second section (the top) engageable with the operating part, said second section integrally joined to said first section and located to extend around said fulcrum (see FIGS. 1 and 2; column 2, line 49 – column 3, line 28).

As to claim 1, Niino does not disclose that the elastic member is being formed as a plate spring, but states that the resilient member in some embodiments may be a leaf spring (column 6, line 39), which is known to be an equivalent to a plate spring.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Niino that any of proposed types of resilient members can be used in the pointing device, a plate spring including.

Art Unit: 2674

As to claim 7, Niino does not emphasize that a yoke (operating unit 4 in FIG.1 or disk 36 in FIG.3) forms a magnetic path, but teaches that the entire unit or disk can be magnetized, and it would have been obvious to one of ordinary skill in the art that it will form a magnetic path (column 4, lines 45-49; column 6, lines 1-3).

7. Claims 1-6 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niino in view of May, US 4,458,114.

Niino discloses a pointing device comprising a base part, an operating part supported on said base part in a rockable manner about a fulcrum, a magnet carried on operating part, and an elastic member arranged between the base part and the operating part.

Niino also teaches that a resilient member can be a leaf spring, but does not teach that it is fixedly supported on said base part as required by claim 2 of the invention, or that said plate spring includes a distal free end engageable with the operating part a proximal end integrally joined to said first section at a position remote from said distal free end and has a length between the distal and proximal ends for exerting a spring action as required by claim 3; or that a plate spring has a generally U-shaped length between the distal and proximal ends for exerting a spring action as required by claim 4.

May teaches a pointing device having a base unit 11 and an operating unit (actuator 20) composed of plates 14 and 15) and a plate spring 13.

As to claim 1, it would have been obvious to one of ordinary skill in the art at the time of the invention to complement the teachings of Niino, that a leaf spring can be used as a resilient member in the pointing device, by the teaching of May, which gives a practical solution of how one can realize this type of resilient support.

Art Unit: 2674

As to claim 2, May teaches the embodiments (FIGS. 1-6), wherein spring is fixedly attached to the base unit by the rivets 13a.

As to claims 3 and 4, the spring in the embodiment in FIG. 5, has all the components as required by the claims.

As to claims 5, 6, 7 and 12-14, Niino teaches the disk 36 with the magnets 45-48 arranged on its surface along the peripheral edge, and as to a forming magnetic path Niino teaches that the entire disk 36 can be magnetized or made of a magnet.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Niino in view of Burnett, US 5,615,083.

Niino discloses a pointing device comprising a base part, an operating part supported on said base part in a rockable manner about a fulcrum, a magnet carried on operating part, and an elastic member arranged between the base part and the operating part.

Niino is not concerned of how to attach the pointing device to a data processor. Burnett teaches a detachable pointing device (joystick 150) having a connector (game port connector 153) adjacent to a base of the joystick to support the joystick while connecting it to a data processor (see FIGS. 1, 2 and column 4, lines 10-61).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a mounting arrangement taught by Burnett for detachable attachment of the pointing device of Niino, because it would solve the problem of selective use of the device in the laptop computers and eliminate the use of cables (see column 3, lines 35-49 of Burnett).

9. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oka in view of Marchis et al., (hereinafter "Marchis"), US 5,543,821.

Art Unit: 2674

Oka discloses a pointing device (16) comprising an operating part (key 17a-d), a detecting part (42-43 in FIG. 7) and a connector part (19) arranged adjacent to the operating part and being detachably attached to a data processor (see FIG. 5) and also serving to support said operating part and detecting part, when the connector is connected to the data processor.

Oka does not disclose that the connecting part is rotatably coupled to a pointing device housing. Marchis teaches a pointing device having a connecting part (chassis 140), which can be detachably attached to a keyboard and allow the pointing device housing to be rotated continuously in all direction to the convenience of a user (abstract, FIG. 2, column 3, lines 20-45).

At the time of the invention it would have been obvious to one of ordinary skill in the art to use rotational attachment arrangement taught by Marchis in the pointing device of Oka to further improve the convenience of using the latter by allowing it to be adjusted in any direction as required by a user.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Youens, US 5,793,355, discloses a detachable input device having supporting connector.

Takeya et al., JP 04-151719, discloses a pointing device having an operating part, a base part, a detecting part, magneto-electric transducers and a resilient member (spring).

Kaneko et al., JP 2000-106065, discloses a pointing device using a plate spring.

Art Unit: 2674

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Eisen whose telephone number is **(703) 306-2988**.

The examiner can normally be reached on M-F (9:00 a.m - 4:00 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on **(703) 305-4709**.

Any response to this action should be **mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or **faxed to:**

(703) 872-9314 (for Technology Center 2600 only).

Hand-delivered responses should be **brought to:** Crystal Park Two, 2121 Crystal Drive, Arlington, Virginia, Sixth Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application or proceeding should be **directed to:** Technology Center 2600 Customer Service Office, whose telephone number is **(703) 306-0377**.

AE

Alexander Eisen
May 22, 2002

Ulka J. Chauhan
ULKA J. CHAUHAN
PRIMARY EXAMINER